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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/349,954	07/08/99	HAYWARD	N 10441Z

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SCULLY SCOTT MURPHY & PRESSER
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GARDEN CITY NY 11530

EXAMINER
SAOUD, C

ART UNIT	PAPER NUMBER
1647	14

DATE MAILED: 06/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/349,954

Applicant(s)
HAYWARD et al.

Examiner
Christine Saoud

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1647



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 4, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-28, 30, and 43-45 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-28, 30, and 43 is/are allowed.
- 6) ☒ Claim(s) 44 is/are rejected.
- 7) ☒ Claim(s) 45 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on 04 April 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/349,954 is acceptable and a CPA has been established. An action on the CPA follows.

Status of Claims

2. Claims 26, 43 and 44 have been amended and claim 45 has been added as requested in paper #13, filed 04 April 2001. Claims 26-28, 30 and 43-45 are pending in the instant application.

Oath/Declaration

3. The Declaration is objected to because it has an address for the inventor Gunther Weber which is illegible. It appears that the Post Office Address was corrected with correction fluid, but the previous address is showing through, which makes the correct address illegible. Correction is necessary.

Drawings

4. Figure 8 of the instant application is presented on separate pages. Although Figures 8A and 8B are correctly labeled according to 37 C.F.R. § 1.84 (U)(1), which requires that when partial views of a drawing which are intended to form one complete view must be identified by the

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same number followed by a capital letter, the Brief Description of the Drawings at page 10 does not properly refer to the Figures, in that lower case letters are used. Correction is required.

Figures 1-6, 9-11, and 16-17 of the instant application are presented in separate panels or on separate pages. 37 C.F.R. § 1.84(u) (1) states that when partial views of a drawing which are intended to form one complete view, whether contained on one or several sheets, must be identified by the **same number followed by a capital letter**. The instant application uses the format of a number followed by lower case roman numerals. Applicant is reminded that once the drawings are changed to meet the separate numbering requirement of 37 C.F.R. § 1.84(u) (1), the specification should be amended to change the Brief Description of the Drawings and the rest of the specification accordingly. If, for example, Figure 1 is divided into Figures 1A, 1B, 1C, and 1D, then the Brief Description and all references to this figure in the specification must refer to Figures 1A, 1B, 1C and/or 1D.

Specification

5. The title of the invention is not descriptive (i.e. "Novel growth factor ..."). A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

6. Claim 44 recites a nucleic acid which "hybridizes under low stringency conditions". There are several factors which affect the hybridization of nucleic acid molecules and there are a

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multitude of conditions which may or may not be considered stringent because stringency is a relative condition. Without some sort of guidance or definition in the claim of what this term is meant to encompass, the metes and bounds of the claim cannot be determined, thereby making the claim indefinite.

Allowable Subject Matter

7. Claims 26-28, 30 and 43 are allowed.
8. Claim 45 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Saoud, Ph.D., whose telephone number is (703) 305-7519. The examiner can normally be reached on Monday to Friday from 7AM to 3PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

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Official papers filed by fax should be directed to (703) 308-4556. If this number is out of service, please call the Group receptionist for an alternate number. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. Official papers should NOT be faxed to 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

April 7, 2001

CHRISTINE J. SAOUD
PRIMARY EXAMINER
Christine J. Saoud